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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/768,274      | 01/25/2001  | Werner Temme         | 24487               | 3642             |

7590 02/24/2005

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/768,274

Applicant(s)

TEMME ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/29/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-22 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-22 and 24-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 18-22 and 24-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims recite an "average molecular mass" without stating what type of average is being claimed, e.g. number, weight, viscosity, z, etc. It is unclear what type of average molecular mass is being claimed. Since these values may differ by a factor of up to 10-20 normally, this is a significant degree of uncertainty in the scope of the instant claims. The claims do not recite number average molecular weight nor refer to the use of GPC and it is improper to read limitations into the claims from the specification. The claims continue to recite an indefinite term as stated above and this rejection is maintained.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-22 and 24-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5959027 Jakubowski et al..

Jakubowski et al. discloses an aqueous polyurethane dispersion for coating substrates including floors. All such coated floors have the ability to have sports played on them. The patentee discloses all of the instantly claimed parameters of the polyurethane except for its molecular weight. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed molecular weight because using the components

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of the specified molecular weights of Jakubowski and the component amounts inferred by the disclosed NCO:OH ratio, e.g. column 3, lines 1-67, particularly lines 50-58, and column 4, lines 1-22 necessarily encompasses the instantly claimed molecular weights of some average type and the choice of the instantly claimed molecular weight from this range inferred by Jakubowski would have provided only predictable results such as predictable polymer viscosity by definition of viscosity average molecular weight and the predictable flowability related to such viscosity which predictably affects the ability of the polymer to be dispersed in water, to give the disclosed particle sizes, and to coalesce into a continuous film on application to the substrate. See column 2, lines 40-67; column 3, lines 1-67, particularly 50-58; column 4, lines 1-67, particularly 20-22; column 5, lines 1-7; column 6, lines 1-11, 19-33, and 56-63; column 7, lines 6-12, 16-17, and 63-65; and the remainder of the document. The prior art particle size and use of surfactant is expected to meet the limitation of the instant claim 22. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use fillers in the coating of the patentee because they are well known for use in coatings and would have been expected to give their known properties to the final coating of Jakubowski, which falls within the scope of the instant claims 24-26 and 28. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the amines of the instant claims 29, 31, 35 in the coating of the patentee because they are well known for use in polyurethanes to keep them from yellowing and are commercially available for this purpose. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the polyurethane of the patentee in accordance with the instant claim 33 because the adhesive nature of polyurethanes will necessarily give such bonding to the individual planks of flooring material conventionally used

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in making floors. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the coating thickness/amount of polyurethane per area of the instant claims 36-37 because this gives only predictable results to the ordinary skilled artisan and is within the ability of the ordinary skilled artisan to choose as evidenced by the patentee's silence to this parameter.

The applicant's arguments have been fully considered but are not persuasive for the reasons stated above. There is no showing of any unexpected result stemming from the use of the instantly claimed molecular weight polyurethane, which is probably encompassed by the recited polyurethane reactant molecular weights of the patentee but in any event would have been obvious for the reasons stated above, particularly with regard to the relationship of viscosity to molecular weight by definition of viscosity average molecular weight and the relationship of viscosity to applying a smooth coating. The reason for expectation of success stems from the patentee's use of their coatings on floors. The applicant's arguments re emulgators are not persuasive since the instant claims do not exclude such external compounds. Those arguments addressing limitations not present in the instant claims are not commensurate in scope with the instant claims and the cited prior art and are therefore not sufficient to overcome the instant rejection.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

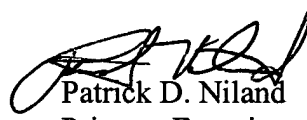
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patrick D. Niland  
Primary Examiner  
Art Unit 1714